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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,959	05/24/2001	Hiroyuki Watanabe	S004-4306	2869
40627	7590	12/28/2006		
ADAMS & WILKS 17 BATTERY PLACE SUITE 1231 NEW YORK, NY 10004			EXAMINER NGUYEN, TRI V	
			ART UNIT	PAPER NUMBER
			1751	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	09/864,959		WATANABE ET AL.	
	Examiner		Art Unit	
	Tri V. Nguyen		1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 20, 2006 has been entered.

Claims 35-38 have been added.

The currently pending claims considered below are Claims 29-38.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 29-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 29 recites a "license request transmission means for transmitting to a credit card settlement center a license request for the credit card settlement reflecting the price discounted by the discount means" in lines 27-30.

Claim 33 recites "discounted credit card settlement information transmission means for transmitting to the credit card settlement center the recreated credit card settlement information to request a license for the credit card settlement" in lines 65-69.

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The examiner remarks that the license request limitation is absent in the original disclosure. Claims 30-32 and 34-38 are dependent on claims 29 and 33 thus inherit the same deficiency.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 29-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 recites a "license request transmission means for transmitting to a credit card settlement center a license request for the credit card settlement reflecting the price discounted by the discount means" in lines 27-30.

Claim 33 recites "discounted credit card settlement information transmission means for transmitting to the credit card settlement center the recreated credit card settlement information to request a license for the credit card settlement" in lines 65-69.

The scope and limitation of a license request transmission is unclear. Claims 30-32 and 34-38 are dependent on claims 29 and 33 thus inherit the same deficiency.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 29-35 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Mankoff (US 2003/0028518).

Claim 29: Mankoff discloses a credit card settlement system comprising:

- a. electronic coupon registration means for registering electronic coupons associated with identification information on a credit card (page 5, parag 45 and pages 6-7, parag. 53-54);
- b. reception means for receiving from a credit card terminal, credit card settlement information including the identification information on the credit card (page 3, parag. 28-30);
- c. electronic coupon search means for searching the electronic coupons registered by the electronic coupon registration means for electronic coupons that are useable in connection with the identification information on the credit card (page 4-5, parag. 41);
- d. electronic coupon availability determination means for determining whether any of the electronic coupons searched by the electronic coupon search means is or is not available for credit card settlement by means of the credit card settlement information (page 3, parag. 28-30 and page 4-5, parag. 41);
- e. electronic coupon determination means for determining whether an electronic coupon determined to be available for credit card settlement by the electronic coupon availability determination means is or is not for a discount (page 3, parag. 28-30);
- f. discount means for giving a discount on a price for the credit card settlement when the electronic coupon is determined to be for a discount by the electronic coupon determination means (page 3, parag. 28-30); and
- g. license request transmission means for transmitting to a credit card settlement center a license request for the credit card settlement reflecting the price discounted by the discount means (page 3, parag. 28-30 and page 4, parag. 38).

Claim 30: Mankoff discloses a credit card settlement system according to claim 29; wherein the electronic coupon registration means comprises at least one of a mobile telephone, a computer connected to a network, and a digital broadcast reception terminal (page 3, parag. 28-30).

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Claim 31: Mankoff discloses a credit card settlement system according to claim 29; further comprising an electronic coupon server

- a. having a database for storing the electronic coupons (page 3, parag. 28-30),
- b. receiving a request for acquisition of an electronic coupon from the electronic coupon registration means (page 3, parag. 28-30; page 3, parag. 28-30 and page 4-5, parag. 41), and
- c. storing the identification information on the credit card in correlation with the electronic coupon (page 3, parag. 28-30 and page 4, parag. 38-40).

Claim 32: Mankoff discloses an electronic coupon issuing system according to claim 31; wherein the electronic coupon server accumulates the search results of searches performed by the electronic coupon search means and accumulates electronic coupon usage information (page 4, parag. 38-40).

Claim 33: Mankoff discloses a credit card settlement system comprising:

- a. a credit card terminal for reading identification information on a credit card used in a credit card settlement (page 3, parag. 28-30);
- b. an electronic coupon server for storing information on electronic coupons associated with the identification information on the credit card (page 3, parag. 28-30); and
- c. a credit card settlement center for
 - i. transmitting to and receiving from a credit card company's server information on the credit card settlement (page 3, parag. 28-30 and page 4, parag. 36),
 - ii. receiving from the credit card terminal credit card settlement information including the identification information on the credit card (page 3, parag. 28-30 and page 4, parag. 35), and
 - iii. requesting the electronic coupon server to search for the electronic coupon associated with the identification information on the credit card;
 - 1. wherein the credit card settlement center comprises credit card settlement information reception means for receiving from the credit card terminal the credit card settlement information including the identification information on the credit card and registration information registered in

advance in the credit card terminal, electronic coupon search condition transmission means for transmitting to the electronic coupon server the received identification information on the credit card and the registration information, electronic coupon search result reception means for receiving from the electronic coupon server the result information on the search for whether there is or is not an electronic coupon available for the credit card settlement and for a discount, and electronic coupon information transmission means for transmitting to the credit card terminal the information of the electronic coupon when the received result information on the search shows there is an electronic coupon available for the credit card settlement and for a discount (page 3, parag. 28-30; page 4-5, parag. 35, 38, 40 and 41);

2. wherein the electronic coupon server comprises electronic coupon registration means for registering the electronic coupons associated with the identification information on the credit card, electronic coupon search condition reception means for receiving from the credit card settlement center the identification information on the credit card and the registration information, electronic coupon search means for searching for whether there is or is not a electronic coupon available for the credit card settlement in the electronic coupons registered by the electronic coupon registration means, electronic coupon availability determination means for determining whether the electronic coupon is or is not for a discount, when there is an electronic coupon available for the credit card settlement as a result of the search by the electronic coupon search means, and electronic coupon search result transmission means for transmitting to the credit card settlement center the information on the electronic coupon, when the available electronic coupon is for a discount as a result of the determination by the electronic coupon availability determination means (page 3, parag. 28-30; page 4-5, parag. 35, 38, 40 and 41); and

3. wherein the credit card terminal comprises reading means for reading the identification information on the credit card, credit card settlement information transmission means for transmitting to the credit card

settlement center the credit card settlement information including the read identification information and the registration information, electronic coupon information reception means for receiving from the credit card settlement center the information on the electronic coupon available for the credit card settlement and for a discount, credit card settlement information recreation means for recreating the credit card settlement information reflecting the price discounted based on the information on the received electronic coupon, and discounted credit card settlement information transmission means for transmitting to the credit card settlement center the recreated credit card settlement information to request a license for the credit card settlement (page 3, parag. 28-30; page 4-5, parag. 35, 38, 40 and 41).

Claim 34: Mankoff discloses a credit card settlement system according to claim 29; wherein the electronic coupon registration means comprises at least one of a mobile telephone, a computer connected to a network, and a digital broadcast reception terminal (page 3, parag. 28-30).

Claim 35: Mankoff discloses a credit card settlement system according to claim 29; wherein the identification information on the credit card comprises a credit card number for the credit card (page 3, parag. 30).

Claim 38: Mankoff discloses a credit card settlement system according to claim 29; wherein the electronic coupon registration means registers electronic coupons associated only with the identification information on the credit card (page 4, parag. 40-41; page 5, parag. 45 and page 6, parag. 53).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff as applied to claim 29 above, and further in view of Ed Perkins ("Not all free-air-trip credit cards are alike", The Plain Dealer, Nov 22, 1998, page 5).

Claims 36 and 37: Mankoff discloses a credit card settlement system according to claim 29; however, Mankoff does not explicitly disclose wherein the credit card comprises a point accumulation card or a mileage accumulation card. In an analogous art, Perkins teaches the feature of credit cards having a reward program with awards points and miles (see abstract). Therefore, it would have been obvious to a skilled artisan to modify the system of Mankoff with the feature of associating the credit card with a points and miles. One would be motivated to provide an incentive program to entice the consumer to apply for the credit thus enhancing profitability.

Response to Arguments

10. Applicant's arguments filed on November 20, 2006 have been fully considered but they are not persuasive.

- a. With regards to claims 29 and 33, the applicant argues that the Mankoff does not disclose "electronic coupons associated with identification on a credit card" (page 11). The examiner respectfully disagrees as Mankoff discloses a Voupon credit card which is used in the same manner as any credit card (for example, it uses the same Visa® type protocol, banking system and billing system - see page 9 of the '611 et seq.).
- b. With regards to claims 29 and 33, the applicant argues that the Mankoff does not disclose "license request transmission" (page 12). The examiner is unclear as to this limitation and respectfully remarks that the specification is silent about this feature as discussed by the applicant on pages 12-13. The examiner notes that

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Mankoff teach the feature of charging the full amount with a subsequent charged discount ('604: page 4, parag. 38 and '611: page 10 et seq.).

- c. Regarding the applicant's remarks of improper incorporation by reference on page 14, the examiner respectfully disagrees as both the '257 and '672 references incorporate the '611 and '352 references in the disclosure. The examiner indicates that the provisional '611 and '352 references disclose various features and embodiments which shown in the non-provisional '518, '257 and '672 references thus the '611 and '352 references are fully incorporated and proper.

Conclusion

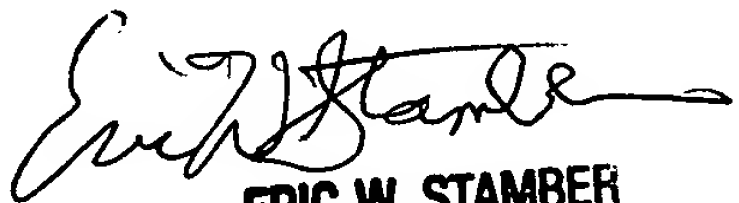
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029 and Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nvt

December 19, 2006

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